

REMARKS

Claims 1-16 and claim 18 remain in the application, claims 17 and 19-31 having been canceled. Claim 7 has been amended to overcome the 37 C.F.R. objection. Claim 1 has been amended to overcome the § 112 rejection. Claims 1 and 15 have been amended to include the limitations of the defects comprising greater than about 30 percent. Support for these amendments can be found in paragraph 18 of the present application, for example. No new subject matter has been added with these amendments.

A. Claim Objections

Claim 7 has been objected to under 37 C.F.R. 1.75(c) as being of improper dependent form. Claim 7 has been amended to overcome the objection. Thus, withdrawal of the objection to claim 7 is respectfully requested.

B. 35 U.S.C. § 112

Claims 1 and 17 have been rejected under 35 USC § 112, second paragraph. Claim 1 has been amended to overcome the rejection, and claim 17 has been canceled. Thus, withdrawal of the rejections to claims 1 and 17 is respectfully requested.

C. 35 U.S.C. § 102(b)

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention

must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Choi- Claims 1, 2, 3, 6, 7, 8, 10, 11, 15, 17

Claims 1, 2, 3, 6, 7, 8, 10, 11, 15, 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Choi et al. reference and also as evidenced by the Sokolowska, Cagin and Ristein references (Office Action, page 3). Choi does not disclose a diamond layer comprising greater than about 30 percent defects, as in amended claims 1 and 15. Therefore, since Choi does not teach or suggest all of the limitations of claims 1 and 15 from which claims 2, 3, 6, 7, 8, 10, 11 depend (claim 17 having been canceled), it is respectfully submitted that these claims are not anticipated by Choi. Since the dependent claims are not anticipated for at least the same reasons as the independent claim from which they depend, the dependent claims will not be addressed at this time. Thus, reconsideration and withdrawal of the Section 102(b) rejection of claims 1, 2, 3, 6, 7, 8, 10, 11, 15, 17 is respectfully requested.

C. 35 U.S.C. § 103(a)

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Choi in view of Catledge-Claims 4, 5, 16, 18

Claims 4, 5, 16, 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Choi in view of Catledge (Office Action, page 5). The Office contends it would have been obvious to include the process parameters of Catledge when performing the method of Choi (to which applicants do not concede).

However, “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” In *re Royka*, 490 F.2d 981,180 USPQ 580 (CCPA 1974). Neither Choi nor Catledge teach or even suggest the limitations of a diamond layer comprising greater than about 30 percent defects, as in amended claims 1 and 15, from which claims 4, 5 and 16, 18 depend respectively. Therefore, these claims are not rendered obvious by Choi in view of Catledge. Thus, reconsideration and withdrawal of the Section 103(a) rejection of claims 4, 5, 16 and 18 is respectfully requested.

Choi in view of admitted prior art-Claim 9

The Office contends it would have been obvious to use RTP as in Choi because the applicant admits it is prior art. However, “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” In *re Royka*, 490 F.2d 981,180 USPQ 580 (CCPA 1974). Because Choi does not teach or even suggest the limitations of claims 1, from which claim 9 depends, this claim is not rendered obvious by Choi in view of admitted prior art. Thus, reconsideration and withdrawal of the Section 103(a) rejection of claim 9 is respectfully requested.

Choi in view of Gasworth-Claim 12

The Office contends it would have been obvious to utilize the cluster tool of Gasworth to form the diamond layer of Choi (to which Applicants do not concede).

However, “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” In *re Royka*, 490 F.2d 981,180 USPQ 580 (CCPA 1974). Because neither Choi nor Gasworth teach or even suggest the limitations of amended claim 1, from which claim 12 depends, claim 12 is not rendered obvious by Choi in view of Gasworth. Thus, reconsideration and withdrawal of the Section 103(a) rejection of claim 12 is respectfully requested.

Choi in view of White-Claim 13

The Office contends it would have been obvious to include the oxidation chamber in a cluster tool according to White while forming the diamond film of Choi.

However, “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” In *re Royka*, 490 F.2d 981,180 USPQ 580 (CCPA 1974). Because neither Choi nor White teach or even suggest the limitations of amended claim 1, from which claim 13 depends, this claim is not rendered obvious by Choi in view of White. Thus, reconsideration and withdrawal of the Section 103(a) rejection of claim 13 is respectfully requested.

Choi in view of Gasworth, Catledge and White-Claim 14

The Office contends claim 14 is obvious in view of Gasworth, Catledge and White.

However, “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” In *re Royka*, 490 F.2d 981,180 USPQ

580 (CCPA 1974). Because neither Choi, Gasworth, nor White teach or even suggest the limitations of amended claim 1, from which claim 14 depends, this claim is not rendered obvious by Choi in view of in view of Gasworth, Catledge and White. Thus, reconsideration and withdrawal of the Section 103(a) rejection of claim 14 is respectfully requested.

In view of the foregoing remarks, the Applicants request allowance of the application. Please forward further communications to the address of record. If the Examiner needs to contact the below-signed Attorney to further the prosecution of the application, the contact number is (480) 715-5488.

Respectfully submitted,

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